

REMARKS

Claims 8, 11, 27, 30 and 33-37 are all the claims pending in the application.

ELECTION/RESTRICTIONS:

Claim 35 -37 were added in the previous amendment to describe that an inner portion of the light-shielding member is in sliding contact with an outermost portion of the box main body when the lid is removed from the box main body.

The Examiner has withdrawn claims 35-37 from consideration because she alleges that these new claims are directed to an invention that is independent or distinct from the invention originally claimed. Applicant respectfully disagrees with the Examiner and therefore traverses the withdrawal of claims 35-37 because the elected Species I (Figures 1-6) supports the features of claims 35-37. As would be appreciated by one skilled in the art and as shown in at least Figure 4, the light-shielding member has an inner portion (i.e., inside face of elements 48B and 48C). The inside portion will contact sides 46B and 46C of the box main body 46 when the printing plate packaging box is closed. Therefore, when the lid 48 is removed, the inner portions of the light shielding member will slide along the outermost portion of the box main body (i.e., sides 46B and 46C). Accordingly, Applicant submits that claims 35-37 read upon the elected figures and should be examined.

35 U.S.C. § 102 and 35 U.S.C. §103 - Kudo:

Claims 8, 27, 30 and 33 are rejected under 35 U.S.C. §102(b) as being anticipated by Kudo (U.S. Patent No. 4,992,815).

Claims 8, 27, 30 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Kudo (U.S. Patent No. 4,992,815).

The rejections are respectfully traversed. Applicant amends claims 8, 30 and 33 to define over the art and expedite prosecution. Kudo neither teaches nor suggests the features of amended claims 8, 30 and 33. For example, these claims recite that the light-shielding member is circumferentially larger than the box main body such that the light-shielding member surrounds and covers an outermost portion of the main body. As will be appreciated, this feature in combination with the other claimed features supplies a beneficial printed plate packaging box not provided by the prior art. In contradistinction, the applied lid 12 of Kudo along with its peripheral edge (applied against the claimed light-shielding member) are circumferentially smaller than the box-main body 13 of Kudo. This is evident from the lid 12 of Kudo (see figure 1) and its features being disclosed within the groove of the applied box main body 13. Further, there is no motivation to modify the lid of the Kudo to have the claimed features.

Accordingly, Applicant submits that amended claims 8, 30 and 33 are neither anticipated by Kudo nor obvious in view of Kudo, and requests that the rejections thereof under 35 U.S.C. § 102(b) and 35 U.S.C. §103(a) be withdrawn. The rejections of dependent claim 27 should also be withdrawn, at least by virtue of claim 27 depending upon claim 8.

35 U.S.C. § 103 - Dirx:

Claims 8, 27, 30 and 33

Claims 8, 27, 30 and 33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Dirx (U.S. Patent No. 5,893,002). This rejection is respectfully traversed.

Applicant amends claims 8, 30 and 33 to define over Dirx. This is done by amending claims 8, 30 and 33 to recite, *inter alia*, that the photosensitive printing plates are in direct contact with the box main body. Dirx does not teach or suggest this feature, but instead teaches explicitly to use the wrapping foils 11 and 12 such that the light-sensitive film sheets are not in contact with the applied box main body 20. Applicant also submits that the art, in general, does not provide motivation to modify Dirx to have the claimed features because Dirx teaches that the wrapping foils 11 and 12 are needed to protect the light-sensitive film sheets. The present printing plate packaging boxes of claims 8, 30 and 33 are configured such that the printing plate is in direct contact with the main body, which provides features not found in Dirx.

Accordingly, Applicant submits that the features of claims 8, 30 and 33 are neither taught nor suggested by Dirx, such that the rejection should be withdrawn. The rejection of dependent claim 27 should also be withdrawn, at least by virtue of claim 27 depending upon claim 8.

35 U.S.C. §103 - Kudo/Dirx/Lermer:

Claims 11 and 34

Claims 11 and 34 are rejected under 35 U.S.C. §103(a) as being unpatentable over either of Kudo or Dirx in view of Lermer (U.S. Patent No. 5,495,944).

It is clear that Lermer discloses a medicine-type bottle, which the Examiner points out includes a shrink wrap. However, the shrink wrapping of an entire bottle of medicine with a thin

polymeric film would not have taught or suggested the presently claimed features of claims 11 and 34, which include a sheet-type material having a smooth and airtight surface that is adhered to an outer surface of an opening and closing lid of a printing plate packaging box.

When relying on multiple references, it is incumbent upon the Examiner to identify some suggestion to combine the references. *In re Mayne*, 104 F.3d 1339, 41 USPQ2d 1451 (Fed. Cir. 1997). Obviousness cannot be established by simply combining the references, absent some suggestion or teaching within the references supporting the combination. *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986).

The asserted motivation is to make the packaging device of the prior art “air tight” and “prevent the contents from damage.” One clearly would not be motivated to wrap the devices of Kudo or Dirx with a shrink wrap to make them airtight, because such a combination would 1) make the prior art devices difficult to open; 2) require an additional application and removal procedure; 3) require additional materials; and 4) would not provide any ascertainable benefit. Further, there is no teaching that shrink wrapping the devices of Kudo or Dirx would prevent any damage, nor do the references disclose that they are susceptible to any damage that would be prevented by shrink wrap. There is clearly no motivation to make such a combination, besides the fact that a medicine bottle is from an area of art that is non-analogous to printing plate packaging boxes. Therefore, the rejection of claims 11 and 34 under 35 U.S.C. §103(a) should be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No.: 09/921,713

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Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

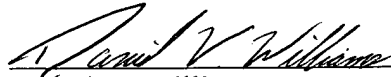
Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER


Daniel V. Williams
Registration No. 45,221

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